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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* EVGENIY M. GETSIN, MICHAEL J. LEWIS,  
and TODD R. COLLART

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Appeal 2008-0863  
Application 09/488,337<sup>1</sup>  
Technology Center 2100

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Decided:<sup>2</sup> April 7, 2009

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Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and  
CAROLYN D. THOMAS, *Administrative Patent Judges*.

Opinion by the Board filed by *Administrative Patent Judge* THOMAS.  
Opinion Concurring-in-part and Dissenting-in-part filed by *Administrative Patent Judge* DIXON.

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<sup>1</sup> Application filed January 20, 2000. The real party in interest is Sonic Solutions.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## DECISION ON APPEAL

### I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-24 mailed June 1, 2006, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### A. INVENTION

Appellants invented a system, method, and computer readable medium for storing synchronization information related to the playback of a multimedia event on a plurality of client apparatuses (Spec., 1:9-11).

### B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-24. Claims 1, 7, 13, and 19 are independent claims. Claim 1 is illustrative:

1. A method for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising the steps of:

providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer are adapted to be connected to a network;

storing information on a host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses;

storing content and timing information transmitted during the simultaneous playback of the event at the host computer; and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback.

#### C. REFERENCES

The references relied upon by the Examiner in rejecting the claims on appeal are as follows:

Ludwig	US 5,978,835	Nov. 2, 1999
Roberts	US 6,161,132	Dec. 12, 2000
Getsin	US 6,769,130 B1	Jul. 27, 2004 (Filed Jan. 20, 2000)
Getsin	US 2004/0244041 A1	Dec. 2, 2004 (effective filing date Filed Jan. 20, 2000)
Getsin	US 6,941,383 B1	Sep. 6, 2005 (Filed Jan. 20, 2000)

#### D. REJECTIONS

The Examiner entered the following rejections which are before us for review:

- (1) Claims 1-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Ludwig;
- (2) Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,769,130 (hereafter ‘130) in view of Ludwig;
- (3) Clams 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,941,383 (hereafter ‘383) in view of Ludwig; and

(4) Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent Application No. 10/880,272 (hereafter ‘272) in view of Ludwig.

## II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed an Appeal Brief (App. Br.) on February 5, 2007. The Examiner mailed an Examiner’s Answer (Ans.) on April 18, 2007. Appellants filed a Reply Brief (Reply Br.) on June 18, 2007.

## III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

### *Roberts*

1. Roberts discloses “[a] script stored on the remote computer accessed over the network is downloaded. The script synchronizes the delivery of the complementary entertainment content with the play of the musical recording” (Abstract).
2. Roberts discloses that “visual content, including interactive content, may be delivered over an on-line service in such a way that it is synchronized to the delivery of content from a musical recording. Such visual content may, for example, be synchronized to the playing of an audio CD in the user’s computer” (col. 2, ll. 19-24).

*Ludwig*

3. Ludwig discloses a “multimedia collaboration system that integrates separate real-time and asynchronous networks . . . in a manner that is interoperable across different computer and network operating system platforms” (Abstract).

4. In Ludwig, “[t]eleconferences may be recorded and stored for later playback, including both audio/video and all data interactions” (col. 3, ll. 13-15).

#### IV. PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.”” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.””)

## V. ANALYSIS

### *Grouping of Claims*

In the Brief, Appellants repeat the same arguments made for claim 1 for each of claims 2-24 (App. Br. 12-17). We will, therefore, treat claims 2-24 as standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

### *Rejection under 35 U.S.C. § 103(a)*

Appellants contend that “the Ludwig patent requires the recording of all content including real time audio and video from all parties along with all shared windows to allow for later playback” (App. Br. 16). Appellants further contend that “[t]he Ludwig patent does not describe or suggest the

playing back with locally stored content and instead teaches away from playing back with locally stored content because Ludwig requires the recording of all content” (*id.*).

The Examiner found that “since the timing and content information of Ludwig includes all content from all parties to be recorded, one of ordinary skill in the art would clearly understand that this would include any references to the locally stored event” (Ans. 9). The Examiner further found that “the locally stored event information is supplied by the Roberts chat room which is synchronized with a CD inserted locally at the client. The combination of Roberts in view of Ludwig will permit the use of the MMCR (MultiMedia Conference Recording) of Ludwig to record the ‘chat room’ conversation of Roberts” (*id. at* 10). Further, regarding the claim limitation of “*allowing the content and timing information to be downloaded . . .*” the Examiner found that “the claim language does not even require that the information be downloaded. The claim states ‘allowing the content and timing information to be downloaded’ (claim 1). A broad interpretation of this limitation merely requires that the system does not forbid the downloading of this information” (Ans. 11).

**Issue:** Have Appellants shown that the Examiner erred in finding that the combination of Roberts and Ludwig discloses storing content and timing information and allowing the content and timing information to be downloaded after the simultaneous playback, as set forth in claim 1?

The Examiner found that Roberts discloses all of the features of claim 1 except for *storing content and timing information . . .* and *allowing the content and timing information to be downloaded . . . for playback . . . after*

*the simultaneous playback* (Ans. 6). As such, the Examiner relies on Ludwig to teach these aforementioned features. As to the other recited elements of claim 1, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Roberts discloses storing a script on a remote computer and downloading the script so as to synchronize the delivery of content with music stored locally on a client's computer (FF 1-2). As such, Roberts discloses storing content and timing information at a host computer and an event stored locally at a client, whereas an "event" reads on any file stored locally. However, claim 1 further requires that content and timing information be stored during the simultaneous playback of the event. Ludwig discloses a multimedia collaboration system that allows teleconferences across different computer and network systems to be recorded and stored for later playback (FF 3-4). Thus, Ludwig shows that it was known in the art at the time of the invention to record information transmitted during simultaneous playback. It does not matter that all information is being recorded instead of only timing and content information. Storing all information certainly includes timing and content information. The recording of information during simultaneous playback is the key factor found. As a result, we find that the combination of Roberts and Ludwig discloses *storing content and timing information transmitted during the simultaneous playback of the event at the host computer*, as set forth in claim 1.

As for the *allowing the content and timing information to be downloaded for playback . . . after the simultaneous playback* feature recited in claim 1, the Examiner found that the claim language does not even require that the information be downloaded, only that it is not forbidden (Ans. 11). We agree.

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the Specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d at 322.

The terms of claim 1, under a broad but reasonable interpretation, do not require actual downloading for playback after the simultaneous playback. Instead, claim 1 only requires that the system is able to download from the network the information for later playback (i.e., “*allowing the content and timing information to be downloaded . . .*”). Furthermore, claim 1 does not require playback of the event (i.e., file) with the downloaded content and timing information. Instead, claim 1 merely requires allowing

playback of both, but not necessarily together. Thus, we find that claim 1 as drafted does not distinguish over Roberts and Ludwig's teachings of allowing later playback of stored information (FF 4).

#### *Teaches Away Arguments*

Appellants contend that "the Roberts patent teaches away from storing timing information and content, and playing back the content and timing information with the locally stored event since this would result in a recorded chat session where the users would not be able to interact and would have no control over the chat session" (App. Br. 17).

The Examiner found that "Roberts clearly discloses a text file [that] can be used to store messages to provide a pre-recorded experience (Ans. 12).

**Issue:** Have Appellants shown that the Examiner erred in combining Roberts and Ludwig because Roberts teaches away from storing information and playing it back later with the event?

As noted *supra*, claim 1 does not require that in the later playback, the event, timing information, and content be played back together. Also, as found by the Examiner, Roberts discloses allowing a pre-recorded experience to be played back for a group of chat users (Roberts, col. 8, ll. 25-30). Similarly, Ludwig discloses later playback of recorded information (FF 4). Thus, both references suggest later playback. We do not find, and Appellants have not established, that Roberts criticizes, discredits, or otherwise discourages the use of storing content and timing information for playback afterwards. "[T]he prior art's mere disclosure of more than one

alternative does not constitute a teaching away from any of these alternative because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed . . .” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). In fact, Roberts discloses performing pre-recorded playback (Roberts, col. 8, ll. 25-30).

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 1335 (Fed. Cir. 2001). We do not find this to be the situation before this Board.

As such, we find that the Examiner has set forth a sufficient initial showing of obviousness and we do not find that Appellants have shown error in the Examiner’s rejection of illustrative claim 1. Therefore, we affirm the rejection of independent claim 1 and of claims 2-24, which fall therewith.

#### *Double Patenting Arguments*

Claims 1-24 are also rejected on the ground of nonstatutory obviousness-type double patenting (Ans. 3-5).

Since Appellants’ arguments regarding the three (3) double patenting rejections (*id.*) rely essentially on the same Ludwig arguments (App. Br. 12-15) which were *not* found persuasive with regard to the Roberts and Ludwig obviousness rejection, we also affirm the double patenting rejection.

## VI. CONCLUSIONS

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-24.

Thus, claims 1-24 are not patentable.

## VII. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-24.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

DIXON, Concur-in-part and Dissent-in-part,

I concur with the majority's affirmance of the rejection under 35 U.S.C. § 103(a).

I dissent from the majority's affirmance of the three rejections under Obviousness-Type double patenting for the following reasons.

MPEP 804 provides a general overview for Obviousness-Type double patenting analysis wherein "an overview of the treatment of applications having conflicting claims (e.g., where a claim in an application is not patentably distinct from a claim in a patent or another application.)"

(Emphasis added.) MPEP 804 further states:

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent. (Emphasis added.)

In the present Examiner's Answer and since the Obviousness-Type double patenting rejections were first made on February 14, 2006, the Examiner has never set forth a proper analysis in the administrative record, nor has the Examiner properly and specifically addressed Appellants' arguments concerning the Obviousness-Type double patenting.

Hence, I find that the Examiner has never established a proper initial showing of Obviousness-Type double patenting as Appellants asserted at pages 20-21 of the Brief. Nor do I find that the Examiner has specifically addressed Appellants' arguments to the combination of Ludwig alone with the claimed inventions as recited in the claims rather than what the patents and published application "discloses" as throughout the Examiner's rejections.

Additionally, I find the Examiner's rejections facially deficient since the Examiner mentions the combination of Roberts and Ludwig in two of the three rejections, but Roberts has not been relied upon in the Obviousness-Type double patenting rejections. In the third rejection, the Examiner states:

Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Application No. 10/880,272 in view of Ludwig. The rationale can be found in above for the rejection by '130 in view of Ludwig. This is the continuation of '130.

I find the Examiner's treatment in this rejection to further compound the prior deficiencies since this application has different claims which have not been addressed by the Examiner in a "provisional" Obviousness-Type double patenting rejection. (Additionally, this application went abandoned after the filing of all the papers in the present appeal to make the rejection MOOT.) Therefore, I find that the Examiner has not set forth a proper initial showing of Obviousness-Type double patenting with the required factual findings as outlined in MPEP 804.

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